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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.         | CONFIRMATION NO.       |
|---|-------------|----------------------|-----------------------------|------------------------|
| 09/827,803  | 04/06/2001  | Efrain Torres        | HILB / 720                  | 6869                   |
| 26875 7590 12/17/2007<br>WOOD, HERRON & EVANS, LLP<br>2700 CAREW TOWER<br>441 VINE STREET<br>CINCINNATI, OH 45202 |             |                      | EXAMINER<br>GART, MATTHEW S |                        |
|   |             |                      | ART UNIT<br>3625            | PAPER NUMBER           |
|   |             |                      | MAIL DATE<br>12/17/2007     | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/827,803

**Applicant(s)**

TORRES ET AL.

**Examiner**

Matthew S. Gart

**Art Unit**

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 4,8-29,59,61,62,65,66 and 70-93 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4, 8-29, 59, 61-62, 65-66 and 70-93 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**


In view of the Appeal Brief filed on 10/01/2007, PROSECUTION IS HEREBY REOPENED.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

  
Jeffrey A. Smith  
SPE  
AU 3625

***Prosecution History Summary***

- Claims 5-7, 30-58, 60, 63-64 and 67-69 have been cancelled.
- Claims 1-4, 8-29, 59, 61-62, 65-66 and 70-93 are pending in the instant application.

***Response to Arguments***

Applicant's arguments, see Appeal Brief, filed 10/01/2007, with respect to claims 1-4, 8-29, 59, 61-62, 65-66 and 70-93 under 35 U.S.C. 103(a) as being unpatentable over Segal in view of Barrott have been fully considered and are persuasive. The finality of the Office Action mailed 2/27/2007 has been withdrawn.

The Applicant argued that Barrott was not prior art against the present application.

Barrott was filed on July 2<sup>nd</sup>, 2001. Barrott is a continuation-in-part of Patent Application No. 09/409,566, which was filed on September 30<sup>th</sup>, 1999. However, Patent Application No. 09/409,566 does not disclose the feature field and the oversized caskets mentioned in paragraph [0101] of Barrott. Patent Application No. 09/409,566 also does not illustrate the feature field of Fig. 9b of Barrott, which paragraph [0101] of Barrott describes. In particular, the feature field is absent from Fig. 9 of Patent Application No. 09/409,566.

The Applicant admits that claims 59, 61-62 and 93 are directed to a program. The Applicant argues that, "...by its very nature [a program] is 'executable by a computer.'" The Applicant further states, "Applicants are not aware of any requirement that a program be positively executed in a program product claim..."

The Applicant is directed to MPEP 2106.01.

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program's functionality to be realized. In contrast,

a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035. Accordingly, it is important to distinguish claims that define descriptive material per se from claims that define statutory inventions.

Computer programs are often recited as part of a claim. USPTO personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory.

Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and USPTO personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material. When a computer program is claimed in a process where the computer is executing the computer program's instructions, USPTO personnel should treat the claim as a process claim.

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When a computer program is recited in conjunction with a physical structure, such as a computer memory, USPTO personnel should treat the claim as a product claim.

***Claim Objections***

Claims 1-4 and 8-29 are objected for minor informalities. Claim 1, line 14 recites, "collectively accord the with the profile parameter that relates to the personal funerary..." There appears to be an extra "the" before the word "with." Appropriate correction is required.



***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 59, 61-62 and 93 are rejected under 35 U.S.C. 101.**

Referring to claims 59, 61-62 and 93. The claims are directed to a computer program per se and accordingly constitutes nonstatutory subject matter. See MPEP 2106.01.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-4, 8-29, 59, 61-62, 65-66 and 70-93 are rejected under 35 U.S.C.**

**103(a) as being unpatentable over Segal (Patent Application Publication 2001/0032093) in view of Buycaskets.com (PTO-892, Ref U, hereinafter, "Buy").**

Referring to claim 1. Segal discloses a computer-implemented method for creating an online funeral plan, the method comprising:

- Generating a plurality of groupings of products and services each associated with a profile parameter that relates to at least one of a personal funerary preference (Segal: paragraph 0024);
- Receiving user input associated with a profile parameter of the plurality of profile parameters to obtain requested pricing information on a product or service offered by a selected funeral service provider among a plurality of funeral service providers (Segal: paragraph 0012 through 0013);
- Retrieving in response to the user input the requested pricing information by accessing a database storing pricing information associated with a grouping of

products and services associated with the profile parameter and offered by the plurality of funeral service providers (Segal: paragraph 0035),

- Wherein the grouping of products and services are preselected to complement each other and complete aspects of funeral planning, and to individually and collectively accord with the profile parameter that relates to the personal funerary preference of the decedent (Segal: paragraph 0039, "5, "The consumer can choose between either a traditional funeral service or a cremation. Either choice will carry a list of options with a description of each option as explained above."),
- Wherein each funeral service provider is associated with a distinct set of products and services from the plurality of products and services, and wherein the database maintains pricing information for the set of products and services associated with each funeral service provider (Segal: paragraph 0035);
- Steering generation of the funeral plan according to the profile parameter that relates to the personal funerary preference of the decedent by prompting user selections from the grouping of products and services associated with the profile parameter (Segal: paragraph 0044); and
- Outputting the requested pricing information to the user (Segal: paragraph 0035).

Segal does not expressly disclose a computer-implemented method for creating an online funeral plan, the method comprising: generating a plurality of groupings of products and services each associated with a profile parameter that relates to at least one of a personal funerary preference and a lifestyle of a decedent. Buy discloses a

profile parameter that relates to a lifestyle of a decedent (Buy: Page 3, "Browse: Jewish").

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the method of Segal to have included the teachings of Buy as discussed above in order to offer caskets designed for special needs (Buy: Page 2).

Referring to claim 2. Segal further discloses a method comprising selecting a funeral service provider from the plurality of funeral service providers in response to the user input (Segal: paragraph 0036).

Referring to claim 3. Segal further discloses a method comprising selecting the funeral service provider from a plurality of funeral homes based on criteria chosen from the group consisting of: location, services, products, capacity, pricing information, appearance and reputation (Segal: paragraph 0035 through 0036).

Referring to claim 4. Segal further discloses a method comprising receiving user input from the user to select a collection of products and services to include in the funeral plan (Segal: paragraph 0032).

Referring to claim 8. Segal further discloses a method comprising processing funding of the funeral plan using a payment method selected from the group consisting of: an electronic debit, credit card, insurance, or trust fund (Segal: paragraph 0028).

Referring to claim 9. Segal further discloses a method wherein the steering of the generation of the funeral plan further comprises personalizing aspects of the funeral plan to reflect a religious, professional, personal, or ethnic desire of a deceased in accordance with the user profile parameter and in response to user input (Segal: paragraph 0044, "Referring to FIGS. 5, 7, 9 and 11, if the user chooses a traditional burial, the user is provided with options for securing a hearse and for buying a casket. Referring to FIGS. 6, 10 and 12, if the user chooses a cremation service, the user is presented with options for cremation providers as well as for purchasing urns. A priest, rabbi or other minister may also be selected to administer the services.").

Referring to claim 10. Segal further discloses a method comprising storing contact information of a family member, friend or associate of the user for notification of a decedent's death (Segal: paragraph 0037).

Referring to claim 11. Segal further discloses a method comprising electronically storing the funeral plan for later retrieval (Segal: paragraph 0022).

Referring to claim 12. Segal further discloses a method comprising initiating the electronic display of the funeral plan on a web site (Segal: paragraph 0020).

Referring to claim 13. Segal further discloses a method comprising modifying the funeral plan in response to user input (Segal: paragraph 0038).

Referring to claim 14. Segal further discloses a method comprising directing user input to a web site, and communicating the pricing information for a products or service to the user via the web site, wherein the pricing information is retrieved from the database (Segal: paragraph 0035 through 0036).

Referring to claim 15. Segal further discloses a method wherein the pricing of a product or service is guaranteed, the method further comprising initiating a display to the user of an electronic image or text representing terms of the guarantee (Segal: paragraph 0039).

Referring to claim 16. Segal further discloses a method comprising initiating the display of an image representative of the product or service to a user (Segal: Fig. 7, "Floral Catalog w/ thumbnails").

Referring to claim 17. Segal further discloses a method comprising scheduling a meeting with a death care professional in response to user input (Segal: paragraph 0027).

Referring to claim 18. Segal further discloses a method comprising initiating the display of contact information to the user enabling personal or electronic communication with the death care professional (Segal: paragraph 0027).

Referring to claim 19. Segal further discloses a method comprising retrieving an estimated cost from the database for a non-guaranteed item. (Segal: paragraph 0039).

Referring to claim 20. Segal further discloses a method wherein the non-guaranteed item is selected from the group consisting of: a floral arrangement, musical performance, clergy, transportation and honorarium costs. (Segal: paragraph 0039).

Referring to claim 21. Segal further discloses a method comprising storing a currency value indicative of client funds that are budgeted to pay for the non-guaranteed item (Segal: paragraph 0039).

Referring to claim 22. Segal further discloses a method comprising storing information related to donations (Segal: paragraph 0037).

Referring to claim 23. Segal further discloses a method comprising initiating the display of a payment status of the funeral plan to the user (Segal: paragraph 0039).

Referring to claim 24. Segal further discloses a method wherein the pricing information includes bids from at least a subset of the plurality of funeral service providers (Segal: paragraph 0035).

Referring to claim 25. Segal further discloses a method comprising relating an offer for the product or service from the user to at least a subset of the plurality of funeral service providers, wherein the offer includes a price range (Segal: paragraph 0034 through paragraph 0035).

Referring to claim 26. Segal further discloses a method comprising associating and recommending to the user a complementary item from the plurality of products and services in response to the user selecting the product or service (Segal: paragraph 0032).

Referring to claim 27. Segal further discloses a method comprising initiating the display of educational information, counseling and Internet links related to the product or service (Segal: paragraph 0027).



Referring to claim 28. Segal further discloses a method comprising verifying the availability of the product or service from among the plurality of funeral service providers (Segal: paragraph 0027).

Referring to claim 29. Segal further discloses a method comprising encrypting user data and funeral plan information in conjunction with creating the funeral plan (Segal: Fig. 1).

Referring to claims 59 and 61-62. Claims 59 and 61-62 contain limitations similar to those as set forth above in claims 1-4 and 8-29. Claims 59 and 61-62 are rejected under the same rationale as set forth above in claims 1-4 and 8-29.

Referring to claims 65-66. Claims 65-66 contain limitations similar to those as set forth above in claims 1-4 and 8-29. Claims 65-66 are rejected under the same rationale as set forth above in claims 1-4 and 8-29.

Referring to claims 70-92. Claims 70-92 contain limitations similar to those as set forth above in claims 1-4 and 8-29. Claims 70-92 are rejected under the same rationale as set forth above in claims 1-4 and 8-29.

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Referring to claim 93. Claim 93 contains limitations similar to those as set forth above in claims 1-4 and 8-29. Claim 93 is rejected under the same rationale as set forth above in claims 1-4 and 8-29.


**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew S. Gart whose telephone number is 571-272-3955. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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